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EXAMINER

REICHLE, KARIN M

ART UNIT

PAPER NUMBER

3761

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/570,483	<b>Applicant(s)</b> HARUKI ET AL.	
	<b>Examiner</b> Karin M. Reichle	<b>Art Unit</b> 3761	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 04 January 2010.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,6,10-12 and 14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,6,10-12 and 14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)         | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)         | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Response to Amendment***

1. The amendments to the specification, i.e. pages 3-6 thereof, have not been entered since they do not comply with 37 CFR 1.121, see sections (b)(1)(ii) and (h) thereof. Not only do the amendments not show all the changes made to the previous version of the paragraphs, e.g. those of 8-6-09, but the abstract section does not begin on a separate sheet, but rather on page 6, i.e. a sheet of the specification section. Therefore, see the following paragraphs.

### ***Specification***

The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

#### **For Example:**

### ***Description***

2. 35 U.S.C. 112, first paragraph, requires the specification to be written in "full, clear, concise, and exact terms." The specification is replete with terms which are not clear, concise and exact. The specification should be revised carefully in order to comply with 35 U.S.C. 112, first paragraph. Examples of some unclear, inexact or verbose terms used in the specification are: page 1, lines 10-24, the paragraph bridging pages 9-10, page 15, second and third full paragraphs, page 18, second full paragraph and the paragraph bridging pages 18-19.

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3. The disclosure is objected to because of the following informalities: 1) The Summary of the Invention section, i.e. a description of the claimed invention, and the invention of the claims should be commensurate, see MPEP 608.01(d) (Note such also refers to MPEP 1302), e.g. where is the process set forth in the Summary claimed in the claims? 2) In the paragraph bridging pages 23-24, first sentence, “as shown in FIG. 8(a),” should be moved to the beginning of the sentence after “More specifically,” to avoid confusion.

### ***Claim Objections***

4. Claims 1, 6, 10-12 and 14 are objected to because of the following informalities: Claim 1, line 28, “said”, one occurrence, should be deleted. Claim 11 is considered dependent from claim 1. However, the preamble of claim 11, i.e. “An assemblage of diapers”, is inconsistent with that of claim 1, i.e. “A folded disposable diaper”. In claim 11, lines 1-2, “of”, one occurrence, should be deleted. Appropriate correction is required.

### ***Claim Language Interpretation***

5. Claims 1, 6, 10-12 and 14, see, e.g., lines 12-16, and 20-28 of claim 1, as best understood, and claim 10, are product by process claims, see MPEP 2113, i.e. [E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process.” In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985).

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Also, lines 20-31 do not set forth when such folding over takes place. Therefore, the end product of claim 1 is considered to the structure set forth on lines 1-19 (It is noted with regard to the waist and leg-hole elastics, it is not clear what end structure would result from attaching in an expanded state, e.g. could be gathered or not) having a fold as set forth on lines 34 and 23-28, and first and second body portions overlaying each other at some time having the function, capability or property set forth on lines 28-31. It is noted that the longitudinal extents of the front, rear and crotch portions relative to the overall extent of the main body have not been set forth. The end product of claim 6 is considered to require the leg hole elastic members not extend into some portion/area having the character thereon. The end product of claim 10 is considered to require printing of the character, i.e. at least a portion of the character in ink, on the diaper main body (It is noted that the dictionary defines “printed” as “lettering or other impressions produced in ink from type by a printing press or other means”). Due to the lack of consistency discussed supra in paragraph 4, claim 11 is considered to require a stack of the diapers of claim 1 with the function, capability or property set forth on lines 4-5. It should be noted that “a side” does not require a particular side or the same side with regard to each of the diapers. Claim 12 is considered to require each leg hole elastic member include two discontinuous sections with an area therebetween in which at least part of the character is disposed. Terminology other than that explicitly defined will be interpreted according to their usual, e.g., dictionary, definition. Therefore, note the definition of “character” listed on the PTO-892, e.g. a graphic symbol, a symbol that represents information, a letter.

***Claim Rejections - 35 USC §103***

6. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

7. Claims 1, 6 and 10-11 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over SCA '845 in view of Cammorata et al '162 and MacDonald '665.

Claim 1: See Claim Language Interpretation section supra, hereinafter also referred to as CLI, and '845 at the Figures, esp. 1 and 4 (note Figure 4 is described as “a diaper”, the abstract (esp. the last sentence, i.e. “on”), page 1, lines 3-7, page 2, lines 25-32, page 3, lines 1-3 and 8-9 (note “on” as well as “or adjacent”) and 23 et seq, page 4, lines 1-3 and 25 et seq, esp. lines 25-26, page 5, lines 1-2, and 10 et seq, esp. lines 10-14 and 23-30, page 6, lines 4-12, esp. lines 8-12, i.e. “on” as well as “or adjacent”, and lines 18-25, esp. lines 19-25 (note language “product”) and its claims, esp. claims 6 and 8, i.e. '845 teaches a folded, see page 6, lines 20-25, disposable diaper (see Figure 1 as well as description of Figure 4 discussed supra), comprising a diaper main body 1 having a front abdomen portion 5, a back portion 6, and a crotch portion 7 interconnecting the front abdomen portion and the back portion, the crotch portion 7 having opposing side edges formed as leg hole sections which are between the abdomen portion and the back portion, see Figure 1, the crotch portion extending widthwise between the leg hole sections, see Figure 1, the front abdomen portion having opposing abdomen side edges and the back portion having opposing back side edges, see Figure 1, the abdomen side edges being respectively joined to corresponding ones of the back side edges to define a waist opening, see the paragraph bridging pages 4-5 and note the claim does not require permanent joining nor a pant diaper, the diaper main body being provided with an absorbent main body 4 at the crotch

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portion, a leg-hole elastic member, i.e. at least one member of each 12, attached along each of the leg hole sections, see CLI supra, the diaper main body having a character (Note discussion of the terminology “character” in CLI supra), 11, indicating a size of the diaper main body and/or indicating a side of the front or back side of the diaper main body, see, e.g., 11, page 3, lines 8-9, page 6, lines 6-10 and the Figures. Claim 1 also still requires 1) waist elastic members attached in an expanded state, see CLI, as well as 2) the diaper main body being folded over at a fold so as to define a first diaper body portion on one side of the fold and a second diaper body portion on another side of the fold, the first and second diaper body portions being overlaid flat on each other, and the fold defining a fold edge face between the first and second diaper body portions, the fold edge face being exposed and facing outward in a direction substantially parallel to first and second planes of the first and second diaper body portions, the character being disposed on the fold edge face, the character being viewable when two or more like folded diaper main bodies are stacked on one another with all the first and second planes of the like folded diaper main bodies parallel to each other, and the fold extending widthwise across the crotch portion, and now requires 3) the character so disposed also be extended to both the first and second diaper body portions. With regard to 1) and 2), while ‘845 does not teach waist elastic members and does not explicitly teach a fold as set forth on lines 34 and 23-28 nor first and second body portions overlaying each other at some time having the function, capability or property set forth on lines 28-31, it does teach an article which can have the design of a diaper pant, see, e.g., page 5, lines 10-14 of ‘845, and a character, e.g., 11, disposed on a fold edge face in the folded package condition of the article, the character being viewable when articles have been taken out of their packages and placed on a shelf or the like, see, e.g., the cited portions of page 6, and

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the character is disposed on/extends on the fold edge face, e.g., 10, extending between the first and second diaper body portions. However, see also '162, at Figures 1-9C and, e.g., paragraphs 1, 6, 9, 14, 21, 30, 36, 48, 56, 68- 73, and 76, and '665 at the Figures and, e.g., col. 2, line 56-col. 3, line 62, col. 4, lines 25-39, col. 7, lines 30-34 and col. 2, lines 25-30, i.e. an absorbent article of diaper pants design includes elastic waist elements as well as is folded in half (i.e. the diaper main body being folded over at a fold so as to define a first diaper body portion on one side of the fold and a second diaper body portion on another side of the fold, the first and second diaper body portions being overlaid flat on each other, and the fold defining a fold edge face between the first and second diaper body portions, the fold edge face being exposed and facing outward in a direction substantially parallel to first and second planes of the first and second diaper body portions, and the fold extending widthwise across the crotch portion fold) and attached at its side edges to form pants (i.e. the diaper main body also being folded along such side edges at folds to have flat portions of the diaper main body overlaid on other flat portions of the diaper main body) and/or folding such diaper pants design for packaged/stored/stacked condition (i.e. folded as discussed supra so as to have one of a rectangular and a square outline when viewed from a direction normal to the flat portions). Therefore to employ a diaper pants design such as, for example, taught by '162 and '665 as the absorbent article of '845 would be obvious to one of ordinary skill in the art in view of the recognition that such design is known to be used in combination with wetness indicators and/or graphics/symbols and the desire of '845 to be an absorbent article with wetness indicators and/or graphics/symbols of a diaper pants design. In so doing, it is the Examiner's first position that the prior art contemplates the diaper of 1) and 2) supra, see CLI, i.e. the structure set forth on lines 1-19 (It is again noted with regard to the waist



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and leg-hole elastics, it is not clear what end structure would result from attaching in an expanded state, e.g. could be gathered or not) having a fold as set forth on lines 34 and 23-28, first and second body portion overlaying each other at some time as well as the function, capability or property set forth on lines 28-31 and the indicia also being disposed on/extends on the fold edge face (see discussion of 3) *infra*, the Examiner's first position with regard thereto). In any case, i.e. the Examiner's second position, at the very least, the prior art contemplates the same structure set forth on lines 1-19 having a fold as set forth on lines 34 and 23-28, the first and second body portions overlaying each other at some time and the character also being disposed on/extends on the fold edge face (see again the discussion of 3), the Examiner's positions with regard thereto). Therefore, there is sufficient factual evidence that such same structure would necessarily and inevitably include the same capability, structure or function claimed, i.e. of lines 28-31. Finally, i.e. the Examiner's third position, if not already, it would be obvious to store or shelve absorbent articles/diaper pants as contemplated by the prior art stacked on one another as claimed, such as, for example taught by '665, e.g. Figure 4, in view of the recognition that such is storage/space efficient and the desire of such, especially in space conscious/economic/efficient situations such as nursing homes or the like. In so doing, the prior art would necessarily and inevitably include the capability, structure or function of lines 28-31, see again CLI *supra* as well as the cited portions of page 6 of '845.

With regard to 3), it is the Examiner's first position that '845 explicitly teaches the character not only disposed on the fold edge face but also extended to both the first and second diaper portions, see again the cited portions of '845, esp. those on page 6 and the claims, i.e. on the strip which strip is "intended to form the fold line", i.e. the fold edge face. In any case, i.e.

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the Examiner's second position, '845 teaches the character not only disposed on the fold edge face but also, at the very least, extended between the first and second diaper portions so that it is easier to find the correct type of product in the case where the articles have been taken out of their packages and placed on a shelf or the like in a storage space and so as to be visible outwardly independently of how the article is put on the shelf. See, e.g., page 6, lines 8-12 and 20-25 of '845 again. Therefore, to extend the character(s) to extend the full extent of the strip/fold of '845, if not already, would be obvious to one of ordinary skill in the art in view of the recognition that such would provide better visibility/visibility outwardly, i.e. easier to find the correct product independently of how it is stored, and the desire of such by '845. Finally, i.e. the Examiner's third position, '845 teaches the character not only disposed on a strip which strip extends longitudinally or transversely, see Figures 1 and 3-4 (note esp. the periodic occurrence of characters in the longitudinal direction of the article of Figures 3-4), thereby forming at least a portion of the fold edge face of a transverse fold, and the desire that the character on the strip makes it easier to find the correct type of product in the case where the articles have been taken out of their packages and placed on a shelf or the like in a storage space and so as to be visible outwardly independently of how the article is put on the shelf. See also '570 at Figures 7-8 and col. 18, line 55-col. 19, line 40, i.e. characters, e.g. denoting size, provided completely along the longitudinal direction or only periodically longitudinally therealong. Therefore, to make the longitudinal periodic character(s) of '845 continuous instead would be obvious in view of the interchangeability as taught by '570 and/or in view of the recognition that such would also provide better visibility/visibility outwardly, i.e. easier to find the correct product independently of how it is stored, and the desire of such by '845.

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Claim 6: The leg-hole elastic members are disposed so as to not extend into an area in the which the character is provided, i.e. see CLI and, e.g., '845, e.g. elastic elements 12 in Figures 1, 3-4 and the character 11 with regard thereto.

Claim 10: The character, e.g. at least a portion thereof, e.g. the size, is printed on the diaper main body by means of an ink-jet system, see CLI and, e.g., page 3, line 8 of '845, i.e. the size is printed.

Claim 11: An assemblage of diapers folded as claimed in claim 1 are stacked on one another in a stack with all the first and second planes of the diapers parallel to each other, and the indicia being viewable from a side of the stack, see CLI supra and the discussion of claim 1 supra, i.e. a stack of the diapers as claimed in claim 1 with the function, capability or property set forth as set forth on lines 4-5 is contemplated, necessarily and inevitably included or obviously contemplated by the prior art.

Claim 14: '845 teaches an absorbent core 4 enclosed between a liquid impervious backsheet which can be a laminate of materials and a topsheet and the character disposed on the backsheet. This claim further requires the core be wrapped with a coating sheet sandwiched between a topsheet and a backsheet (note that such backsheet is not required to be impervious), the combination forming the absorbent main body, an inner sheet and an outer sheet forming the diaper main body (note that such sheets are not required to be the innermost or the outermost, resp.), the backsheet being bonded (i.e. includes direct or indirect bonding) to the inner sheet at the crotch portion and the character disposed on such outer sheet. See, however, e.g., '162 at paragraph 74, i.e. multilayered laminate forms outermost sheets, i.e. two or more layers, paragraphs 48, 97, 101 and 103-106 and the discussion of claim 1, i.e. "Therefore to employ a

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diaper pants design such as, for example, taught by '162 and '665 as the absorbent article of '845 would be obvious to one of ordinary skill in the art in view of the recognition that such design is known to be used in combination with wetness indicators and/or graphics/symbols and the desire of '845 to be an absorbent article with wetness indicators and/or graphics/symbols of a diaper pants design." In so doing, the prior art contemplates an absorbent main body formed by sandwiching an absorbent core, wrapped with a coating sheet, see, e.g., '162 at paragraph 101, between a top sheet and a back sheet, the latter being, e.g., the innermost layer of a multi-layered laminate structure of an outer cover, see, e.g., pages 4, lines 2-3 of '845 and paragraph 74 of '162, esp. the third sentence thereof, and the diaper main body includes an inner sheet, e.g., another layer of such multi-layered laminate but not the innermost, and an outer sheet, e.g. a third layer of such multi-layered laminate which is more outward/outermost, the back sheet of the absorbent main body is bonded, i.e. at least indirectly, to the inner sheet of the diaper main body at the crotch portion, and the character is disposed on such outer sheet, see the cited portions of '845 as well as paragraphs 104-106 of '162.

8. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over SCA 'PCT '845, Cammorata et al '162 and MacDonald '665 as applied to claim 1 above, and further in view of Igaue et al '241.

This claim requires the leg-hole elastic member of each of the leg hole sections include two discontinuous sections with a break area, at least a portion of such having the character disposed therein and an area in which the leg hole elastic member is provided but the character is absent. While the prior art, e.g. '845, contemplates each of the leg hole sections having a continuous leg-hole elastic member to provide a sealing effect around the respective leg, an area

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between the leg hole sections, at least a portion of such area between such sections having the character disposed therein and an area in which the leg hole elastic members are provided but the character is absent, see, e.g. the discussion of claim 6, it does not contemplate the claimed structure. See, however, '241 at the Figures and col. 3, lines 52-57 and col. 4, lines 51 et seq. Therefore to make the continuous leg hole elastic member of each of the leg hole sections of '845 discontinuous members instead as taught by '241 would be obvious to one of ordinary skill in the art in that such would simplify production promoting high speed production of the absorbent article and mass production at a low cost and the desirability of such in any disposable absorbent article. In so doing, the prior art contemplates the leg-hole elastic member of each of the leg hole sections includes two discontinuous sections, e.g. the portions at the front and back portions, with a break area, e.g. therebetween, i.e. the crotch portion, at least a portion of such area having the character disposed therein, see discussion of claims supra, e.g. discussion of claim 1, line 34, and an area in which the leg hole elastic member is provided but the character is absent, see, e.g., the discussion of claim 6 again.

### ***Response to Arguments***

9. Applicant's remarks have been carefully considered but are either deemed moot in that the issue discussed has not been reraised or deemed not persuasive in light of the discussion supra. Specifically Applicant's remarks are now narrower than the claim language, the teachings of the prior art and the rejections relying thereon. For example, the rejection is not based on each of the documents alone as argued but rather on the combination of the teachings thereof. For another example, '845 does teach the symbols on the strip 10 which strip, as admitted by

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Applicant, see, e.g., page 15, line 13, is arranged at a folding line, i.e. intended to form the fold line. Applicant's attention is again invited to MPEP 2106.01, fourth full paragraph, with regard to patentable weight accorded to printed matter.

### ***Conclusion***

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any new grounds of rejection were necessitated by the amendments to claims 1, 6 and 10-12 and the addition of claim 14.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Karin M. Reichle whose telephone number is (571) 272-4936. The examiner can normally be reached on Monday-Thursday.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tanya Zalukaeva can be reached on (571) 272-1115. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Karin M. Reichle/  
Primary Examiner, Art Unit 3761

March 2, 2010